

Application No. 10/789,094

REMARKS

Claims 1-29 are pending. Currently, claims 1-29 stand as rejected, and Applicants respectfully request reconsideration of the rejection in view of the following comments.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,089,366 (the '366 patent) in view of U.S. Published Application 2003/0113643 to Law (the '643 application). More specifically, the Examiner asserted that the '366 patent "teaches similar photoreceptors where the charge transport material contains a phenothiazine group, a phenoxazine group or a phenazine group (col. 27-30)." Additionally, the Examiner asserted that the '366 patent "does not specifically teach linking multiple phenothiazine groups, phenoxazine groups or a phenazine groups together. Law teaches linking similar charge transport materials together through the use of a linking group in similar organophotoreceptor applications." Applicants submit that the combination of the '366 patent and the '643 application does not render Applicants' invention, as claimed in independent claims 1, 10, 18 and 25, prima facie obvious. Applicants respectfully request reconsideration of the rejection based on the following comments.

As an initial matter, Applicants note that the '643 application was filed before, but published after, the filing date of the provisional application to which the present application claims the benefit of priority. More specifically, the present application claims the benefit of priority from U.S. Provisional Patent Application 60/474,542, which was filed on May 30, 2003. The '643 application was filed on September 27, 2002, and was published on June 19, 2003. Since the '643 application was published after the filing date of the provisional application to

Application No. 10/789,094

which the present application claims the benefit of priority, the '643 application appears to only be an available prior art reference under 35 U.S.C. § 102(e). Additionally, "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c). Applicants submit that the subject matter of the '643 application and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Based on the publication date of the '643 application and the filing date provisional application to which the present application claims the benefit of priority, the '643 application does not appear to be a proper reference for an obviousness rejection, and therefore the combination of the '366 patent and the '643 application does not render Applicants' claimed invention prima facie obvious.

Moreover, even assuming *arguendo* that the '643 application is an available reference, there is no motivation for combining the '366 patent and the '643 application to form Applicants' claimed charge transport compounds. More specifically, the '366 patent does not teach, suggest or motivate linking these particular compositions together. Additionally, the '643 application relates to charge transport compounds comprising a carbazole group and a linking group, wherein the linking group connects one carbazole group to another carbazole group. The linking groups of the '643 patent are specifically disclosed as linking carbazole groups, and the '366 patent does not disclose or suggest the use of linking groups generally. Since there would be no motivation provided by the references to do so, there is no motivation to incorporate the

Application No. 10/789,094

linking groups of the '643 application to link the phenothiazine group, phenoxazine group or phenazine groups of the '366 patent. Since there is no motivation to combine the '366 patent and the '643 application, the combination of the '366 patent and the '643 application does not render Applicants' claimed invention prima facie obvious.

Since the combination of the '366 patent and the '643 reference does not render Applicants' invention, as claimed in independent claims 1, 10 18 and 25, prima facie obvious, Applicants respectfully request the withdrawal of the rejection of claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over the '366 patent in view of U.S. Published Application 2003/0113643.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Brian L. Jarrells
Registration No. 53,067

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1535